

REMARKS

This Application has been reviewed carefully in light of the Final Office Action mailed September 9, 2004 ("*Final Office Action*"). Claims 1-14 were pending in the Application and stand rejected. Applicant amends Claims 1 and 7 to advance prosecution. Applicant also amends Claim 11 to correct a typographical error. Applicant respectfully requests reconsideration and favorable action in this case.

Claim Rejections – Double Patenting

The Examiner rejects Claims 1 and 7 as unpatentable under the judicially created doctrine of "obviousness-type" double patenting with respect to claim 1 of U.S. Patent No. 6,757,888. The Examiner also rejects Claims 1 and 7 as unpatentable under the judicially created doctrine of "obviousness-type" double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,757,888 in view of NetBuilder: an environment for integrating tool and people, Dabke, P. et al. 1998, pages 465-472. The Examiner also rejects Claims 1 and 7 as unpatentable under the judicially created doctrine of "obviousness-type" double patenting with respect to claim 1 of U.S. Patent No. 6,651,121 in view of U.S. Patent No. 6,370,575. The Examiner also rejects Claim 1 and 7 as unpatentable under the judicially created doctrine of "obviousness-type" double patenting with respect to claims 1 and 11 of U.S. Application No. 09/658,563, which was allowed on 7/29/04.

Applicant encloses a Terminal Disclaimer to obviate these "obviousness-type" double patenting rejections.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejects Claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,860,375, which issued to McCubrey et al. ("*McCubrey*"). To anticipate a claim, a single prior art reference must describe, either expressly or inherently, each and every element of the claim. M.P.E.P. § 2131.

Applicant's Claim 1, as amended, recites:

A method, comprising the steps of:
providing a set of predetermined function definitions
which are different, at least one of said predetermined function
definitions defining a function for editing image data;

storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;
executing said project definition; and
automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.

Applicant respectfully submits that *McCubrey* fails to describe every element of this claim.

Among other aspects of Claim 1, *McCubrey* fails to describe “automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.” As teaching this element, the Examiner cites to data paths 34 shown in Figure 1 of *McCubrey*. The Examiner also cites to discussion in *McCubrey* regarding using one of a plurality of image destination paths to route pixel data from an image combiner back to image memory. *McCubrey*, Col. 3, lines 6-10, 42-57. However, *McCubrey* discloses that image data paths 34 represent buses for routing data within local processing system 10. *McCubrey*, Col. 5, line 22–Col. 6, line 2; Figure 2. Applicant respectfully submits that routing data within a local processing system fails to describe “automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.”

For at least this reason, Applicant respectfully submits that *McCubrey* fails to describe, either expressly or inherently, each and every element of Claim 1. For analogous reasons, Applicant respectfully submits that *McCubrey* fails to describe, either expressly or inherently, each and every element of Claim 7. Thus, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 1 and 7.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejects Claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Workflow Management Coalition the Workflow Reference Model, Hollingsworth D., TC00-1003, Jan. 95 (“*Hollingsworth*”) in view of U.S. Patent No. 5,974,431, which issued to Iida (“*Iida*”). To establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03.

Applicant’s independent Claim 1, as amended, recites:

A method, comprising the steps of:
providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data;
storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;
executing said project definition; and
automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.

Applicant respectfully submits that *Hollingsworth* in view of *Iida* fails to teach or suggest every element of this claim.

Among other aspects of independent Claim 1, *Hollingsworth*, alone or in combination with *Iida*, fails to teach or suggest “automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.” As teaching this element, the Examiner cites to various sections of *Hollingsworth*. First, the Examiner cites *Hollingsworth*’s discussion of distribution and system interfaces found in section 2.1.4. However, this section merely discloses that tasks

and information may be distributed among participants in a workflow environment using various communications mechanisms. Next, the Examiner cites to Figure 2. However, Figure 2 merely illustrates that workflow “may involve the transfer of tasks between different vendors['] workflow products to enable different parts of the business process to be enacted on different platforms or sub-networks using particular products suited to that stage of the process.” *Hollingsworth*, page 9. Next, the Examiner cites to *Hollingsworth*’s discussion of interfaces on page 9. However, this discussion merely states that *Hollingsworth* defines interfaces “to support interoperability between different workflow systems,” “to support interaction with a variety of IT application types,” “to support interaction with user interface desktop functions,” and “to provide system monitoring and metric functions to facilitate the management of composite workflow application environments.” Last, the Examiner cites to page 49 of *Hollingsworth*. However, nowhere on page 49 does *Hollingsworth* teach or suggest “automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.” Furthermore, *Iida* fails to teach or suggest this element of independent Claim 1 that is not shown by *Hollingsworth*.

For at least these reasons, Applicant respectfully submits that *Hollingsworth* in view of *Iida* fails to teach or suggest every element of independent Claim 1. For analogous reasons, Applicant respectfully submits that *Hollingsworth* in view of *Iida* fails to teach or suggest every element of independent Claim 7. Claims 2-6, 11, and 12 depend from and therefore include all elements of independent Claim 1. Claims 8-10, 13, and 14 depend from and therefore include all elements of independent Claim 7. Thus, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 1-14.

Furthermore, various dependent claims present additional elements not described by *Hollingsworth* in view of *Iida*. Consider dependent Claims 11 and 13. For example, Claim 11, as amended, recites:

A method according to Claim 1, wherein transmitting said communication occurs after editing a predetermined number of images.

As teaching the elements of Claim 11, the Examiner first cites to Figure 2 in *Hollingsworth*. Figure 2 illustrates that workflow “may involve the transfer of tasks between different vendors['] workflow products to enable different parts of the business process to be enacted on different platforms or sub-networks using particular products suited to that stage of the process.” *Hollingsworth*, page 9. The Examiner also cites to discussion in *Iida* regarding enlarging or reducing vector graphic data and restructuring enlarged or reduced vector graphic data into image graphic data. *Iida*, Col. 3, lines 31-35. However, Applicant respectfully submits that the transfer of tasks between platforms and the enlarging or reducing of vector graphic data, either alone or in combination, fails to teach or suggest “wherein transmitting said communication occurs after editing a predetermined number of images.”

For at least these reasons, Applicants respectfully submit that *Hollingsworth* in view of *Iida* fails to describe, either expressly or inherently, each and every element of dependent Claim 11. For analogous reasons, Applicants respectfully submit that *Hollingsworth* in view of *Iida* fails to describe, either expressly or inherently, each and every element of dependent Claim 13. Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of dependent Claims 11 and 13.

Also consider dependent Claims 12 and 14. For example, Claim 12 recites:

A method according to Claim 1, wherein said communication identifies an occurrence of a predefined condition.

As teaching the elements of Claim 12, the Examiner again cites to Figure 2 in *Hollingsworth*. Again, however, Figure 2 merely illustrates that workflow “may involve the transfer of tasks between different vendors['] workflow products to enable different parts of the business process to be enacted on different platforms or sub-networks using particular products suited to that stage of the process.” *Hollingsworth*, page 9. Applicant respectfully submits that the transfer of tasks between platforms fails to teach or suggest “wherein said communication identifies an occurrence of a predefined condition.”

For at least these reasons, Applicants respectfully submit that *Hollingsworth* in view of *Iida* fails to describe, either expressly or inherently, each and every element of dependent Claim 12. For analogous reasons, Applicants respectfully submit that *Hollingsworth* in view

of *Iida* fails to describe, either expressly or inherently, each and every element of dependent Claim 14. Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of dependent Claims 12 and 14.

In addition, Applicant respectfully submits that Claims 1-14 are patentable over *Hollingsworth* in view of *Iida* because there is no teaching, suggestion, or motivation to combine or modify the teachings of *Hollingsworth* and *Iida* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The M.P.E.P. discusses the strict legal standard for combining or modifying references. As discussed in the M.P.E.P., “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. “The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation . . . is an ‘essential component of an obviousness holding.’ ” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). Furthermore, while “evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, . . . [t]he range of sources available . . . does not diminish the requirement for actual evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. See *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

In the present case, the *Final Office Action* includes only two conclusory statements addressing whether there is any teaching, suggestion, or motivation to combine or modify the teachings of *Hollingsworth* in view of *Iida*:

It would have been obvious to one ordinary skilled in the art [sic] at the time the invention was made given the suggestion of Hollingsworth of the applicability of his teachings to image processing applicable in other IT application [sic], the teachings of Iida for image processing would be readily apparent [sic]. One would be motivated to apply the secondary reference's teachings because in doing so multiple user [sic] have available for retrieval image data in one of several formats including image data and document data or a combination thereof, wherein the common source library database may store any type of data which can be repeatedly used.

Final Office Action, page 6. Neither statement cites to any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Hollingsworth* in view of *Iida*.

The first statement may be alluding to *Hollingsworth*'s discussion of image processing on page 10. However, *Hollingsworth* discusses image processing with regard to workflow management only. Image processing in the workflow management context concerns capturing paper-based information as images and passing the images between a number of different participants in the workflow environment. *Hollingsworth*, section 2.2.1, page 10. Applicant respectfully disagrees that capturing paper-based information as images and passing the images between a number of different participants provides any suggestion or motivation to combine *Hollingsworth* with *Iida*.

Furthermore, the second statement merely asserts that the teachings of *Iida* would improve the teachings of *Hollingsworth*. Applicant respectfully submits that this unsupported statement fails to provide the required teaching, suggestion, or motivation to combine. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For this additional reason, Applicant respectfully submits that Claims 1-14 are allowable over *Hollingsworth* in view of *Iida*.

Objection to Examiner's Characterization of Invention

On page three of the *Final Office Action*, the Examiner comments on what the Examiner believes the invention "relates to" and also presents a "Claim terminology interpretation in light of the specification." Applicant respectfully objects to the Examiner's characterization of the invention and does not admit to any characterization, definition, or limitation of the claims by the Examiner.

CONCLUSION

Applicant has made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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